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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,289	04/22/2004	Ping Te Huang	MR1683-542	7237

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EGBERT LAW OFFICES  
412 MAIN STREET, 7TH FLOOR  
HOUSTON, TX 77002

EXAMINER
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DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/829,289

Applicant(s)

HUANG, PING TE

Examiner

Matthew F. DeSanto

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3763

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102 and/or 35 USC § 103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zdeb (USPN 5,205,823).

Zdeb discloses a plunger of a syringe, comprising: a shank (230) adapted to be partially movably received in a barrel of the syringe, the shank including a first end having a thumb rest (234) radially extending therefrom and a second end having a stub longitudinally extending from the shank, the stub including a stopper (436) radially extending therefrom and a mushroom-shaped connector (430,238,516) formed on a distal end of the stub, at least one annular flange (432) radially extending from the stub between the stopper and the mushroom-shaped connector; and a rubber bulb (236) securely longitudinally mounted to the stub, abutting the stopper and fully containing the at least one annular flange and the mushroom-shaped connector (Fig. 43), but is silent

to the method of molding. The claimed phrase "rubber bulb being previously formed and connected with the shank when inject molding the shank" is being treated as a product by process limitation; that is that the shank is injected molded. As set forth in the MPEP 2113, product by process claims are not limited to the manipulations of the recited steps, only the structure to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haber et al. (USPN 4,944,723).

Haber et al. discloses a plunger of a syringe, comprising: a shank (2) adapted to be partially movably received in a barrel of the syringe, the shank including a first end having a thumb rest (14) radially extending therefrom and a second end having a stub longitudinally extending from the shank, the stub including a stopper (16) radially extending therefrom and a mushroom-shaped connector (22,24) formed on a distal end of the stub, at least one annular flange (20) radially extending from the stub between the stopper and the mushroom-shaped connector; and a rubber bulb (4) securely longitudinally mounted to the stub, abutting the stopper and fully containing the at least one annular flange and the mushroom-shaped connector (Fig. 2), but is silent to the method of molding. The claimed phrase "rubber bulb being previously formed and connected with the shank when inject molding the shank" is being treated as a product by process limitation; that is that the shank is injected molded. As set forth in the MPEP

2113, product by process claims are not limited to the manipulations of the recited steps, only the structure to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haber et al. as applied to claim 1 above, and further in view of McConnaughey (USPN 2,895,773).

Haber et al. discloses the claimed invention except for the stub comprising two annular flanges.

McConnaughey discloses several different types of piston constructions for hypodermic syringes and specifically recites one type of construction wherein the piston head had a mushroom shaped head, and two annular flanges (see column 6, line 15-46 and figure 4, 4a). McConnaughey discloses using this type of piston head construction because of the added benefit of having a third ring that allows additional contact points with the barrel, thus accentuating the effectiveness of the seal without reducing the

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freedom with which the piston will slide forward when actuated by the user (see Column 6, line 30-46).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the syringe of Haber et al. with a second annular flange attached to the piston/plunger as disclosed by McConnaughey because McConnaughey taught the additional benefits that will occur when a piston head has two annular flanges.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact (EBC) at 866-217-9197.



Matthew DeSanto  
Art Unit 3763  
March 19, 2006